

Appln. No. 10/616,753
Docket No. 130373/GEN-0346

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REMARKS / ARGUMENTS

Status of Claims

Claims 1-39 are pending in the application and stand rejected. Applicant has not amended any claims, but instead provides clarifying remarks to distinguish the claimed invention over the prior art of record, thereby leaving Claims 1-39 for consideration.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

The accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in more detail of the position by the final rejection, which introduced the Anderson reference and new grounds of rejection.

Rejections Under 35 U.S.C. §103(a)

Set-I: Claims 1, 2, 6, 8, 9, 10, 16, 22, 23, 27, 29, 30, 31 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over H.C. Anderson (U.S. Patent No. 3,440,528, hereinafter Anderson) in view of Kane (U.S. Patent No. 4,614,925, hereinafter Kane).

Set-II: Claims 3, 7, 24 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and further in view of Roberts Jr. et al. (U.S. Patent No. 6,661,634 hereinafter Roberts Jr.).

Set-III: Claims 4, 5, 17, 25, 26 and 38 are rejected under U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Havot et al. (U.S. Patent No. 5,121,078, hereinafter Havot).

Set-IV: Claims 11 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Brandeau (U.S. Patent No. 4,750,266, hereinafter Brandeau).

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Set-V: Claims 12 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Shimada et al. (U.S. Patent No. 6,020,867, hereinafter Shimada).

Set-VI: Claims 13, 14, 18, 19, 34, 35 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Stahl (U.S. Patent No. 5,388,021, hereinafter Stahl).

Set-VII: Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson, in view of Roberts Jr.

Set-VIII: Claims 15 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Bender (U.S. Patent No. 6,926,288, hereinafter Bender).

Set-IX: Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Knigge et al. (U.S. Patent No. 6,639,779, hereinafter Knigge).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Additionally, Applicant respectfully submits that obviousness cannot be supported by a proposed modification that would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01.

Furthermore, Applicant respectfully submits that “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination

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that was made by the applicant.” *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing: *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There must also be a reasonable expectation of success in modifying or combining the prior art, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 USPQ2d 1016, 1023 (Fed. Cir. 1996). And, there must be some degree of predictability in showing the reasonable expectation of success. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); MPEP §2143.03.

Regarding Set-I:

The Examiner acknowledges that Anderson is deficient in teaching each and every element of the claimed invention, and looks to Kane to cure this deficiency. Paper No. 20061015, page 3.

Applicant respectfully disagrees that Kane cures the deficiencies of Anderson with respect to teaching each and every element of the claimed invention arranged so as to perform as the claimed invention performs, and disagrees that Kane can be used to modify Anderson without rendering Anderson unsatisfactory for its intended purpose. As such, Applicant submits that a prima facie case of obviousness cannot be established.

Regarding independent Claims 1 and 22, Applicant is claiming a filtering apparatus and method that includes, inter alia:

“...an impedance comprising a first conductor on a first layer of a circuit card forming a distributed inductance in series with said first filter, said impedance also including a second conductor on a second layer of said circuit card operably connected to a ground, said first conductor and said second conductor forming a distributed capacitance, and wherein said impedance is configured to facilitate matching of an input impedance of the filtering apparatus with that of a voltage source and said distributed inductance and said distributed capacitance cooperate to provide filtering of electromagnetic interference.”

Dependent claims inherit all of the limitations of the respective parent claim.

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As claimed, the *first conductor* on a first layer forms *a distributed inductance* in series with the first filter, the *second conductor* on a second layer is *operably connected to ground*, and the first conductor and the second conductor form a distributed capacitance.

In alleging obviousness, the Examiner references Kane at col. 11, lines 35-39 and Fig. 16(a). Here, Applicant finds Kane element 105 to be a distributed inductance (allegedly the claimed first conductor that forms a distributed inductance), and the left side of element 105 to be connected to ground (allegedly the claimed second conductor operably connected to ground).

First, in comparing Kane as referenced with the claimed invention, Applicant finds Kane element 105 to form a distributed inductance *and* to be connected to ground (Kane Figure 16(a)), and therefore cannot teach the claimed limitation of "*a first conductor on a first layer* of a circuit card forming *a distributed inductance* in series with said first filter, said impedance also including *a second conductor on a second layer* of said circuit card *operably connected to a ground*, said first conductor and said second conductor forming a distributed capacitance", since Kane teaches the first conductor connected to ground.

Second, it appears that the Examiner is finding elements in a secondary reference (Kane) and merely adding them to the primary reference (Anderson), with no consideration as to how the secondary elements effect the operation of the device in the primary reference, or whether the modified primary reference is still capable of performing as the claimed invention performs.

As best understood by Applicant, Anderson is directed to an AC filter that is designed to match the impedance of a cable at power frequency (col. 2, lines 36-38), and for filtering out frequencies that are substantially higher than the power frequency (col. 2, lines 33-35). Applicant also finds the Anderson high pass filter 20 (col. 3, line 32 and Figure 2) to be coupled to the low pass filter 16 (col. 3, lines 44-45 and Figure 2) via the capacitor 44 in power separator 18, and to ground via resistor 46 (col. 4, lines 36-38 and

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Figure 2). As such, Applicant finds the Anderson low pass filter 16 to be kept at a voltage substantially above ground potential via capacitor 44 and resistor 46.

In view of the foregoing construction of the Anderson filter, and the intended purpose of the Anderson filter, it is unclear to Applicant how the Examiner can conclude that a modification to Anderson by introducing elements of Kane will not result in the modified Anderson being unsuitable for its intended purpose.

For example, if the grounded inductor of Kane (Fig. 16(a)) were to be placed in series with the low pass filter 16 of Anderson, then the low pass filter of Anderson would be grounded, which is completely contrary to Figure 2 of Anderson where the low pass filter 16 is kept at a voltage substantially above ground potential via capacitor 44 and resistor 46.

Alternatively, if the grounded second conductor of the claimed invention (allegedly taught by Kane) were to be placed in series with the low pass filter 16 of Anderson, then the low pass filter of Anderson would again be grounded, which again is completely contrary to Figure 2 of Anderson where the low pass filter 16 is kept at a voltage substantially above ground potential via capacitor 44 and resistor 46.

Additionally, as disclosed in Applicant's application, the construction of the claimed invention is directed to a DC voltage surge suppressor with distributed capacitance EMI filtering and impedance matching. If the modified Anderson were to be applied as the claimed invention is intended to be applied, then Anderson would result in its high pass filter 20 becoming completely non-functional because the Anderson capacitor 44 would block out any DC signal. As such, Applicant submits that the modified Anderson will not be capable of performing as the claimed invention performs.

Not only does Applicant find the modified Anderson to be unsuitable for its original intended purpose, but also finds the modified Anderson incapable of performing as the claimed invention performs.

If the Examiner maintains the rejection of the claimed invention on obviousness grounds by using Kane to modify Anderson, Applicant respectfully requests clarification as to how the modified Anderson is capable of performing the function of the claimed

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invention while still being suitable for its original intended purpose. Without such clarification, Applicant submits that one skilled in the art would not be motivated to use Kane to modify Anderson as alleged by the Examiner to arrive at Applicant's claimed invention.

Regarding Sets II-IX:

In view of the references in Sets II-IX not being applied against the independent claims, the remarks set forth above regarding the allowability of the independent claims, and the fact that dependent claims inherit all of the limitations of the respective parent claim, Applicant submits that all claims in Sets II-IX are allowable at least for the reason that they depend from an allowable claim.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed, thereby resulting in the application being in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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